

REMARKS

The Office Action has been carefully considered. Claims 30-65 were pending. Claims 35-66, which were inadvertently misnumbered as 34-65, have been renumbered as 35-66. Also, claims 36-66 have been cancelled without prejudice. Applicant reserves the right to prosecute the cancelled claims in one or more related applications.

After entry of the above amendments, claims 30-35 will be pending in the present application.

Entry of the above claim amendments and reconsideration and allowance of the present application in view of the following remarks are respectfully requested.

I. CLAIM REJECTION

Claims 30-35 have been rejected under 35 U.S.C. §102(e) as allegedly being anticipated by United States Patent No. 6,379,379 to Wang ("Wang"). This rejection is respectfully traversed.

A claim is anticipated only if *each and every* element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added).

Independent claim 30 recites a medical device having a coated tube-like portion comprising at least one laser-ablated opening extending through the coated portion. The opening is formed by ablating a coated structure with a laser. Claims 31-35 depend from claim 30 and, thus, also include the recitations of claim 30.

Wang does not teach or suggest a medical device having a coated portion comprising at least one laser-ablated opening extending through the coated portion as required by claim 30. Wang also does not disclose or suggest that the medical device is manufactured by ablating the coated structure with a laser to form at least one opening extending through the coated portion as required by claim 30.

According to MPEP § 2113, "[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where . . . the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product." As stated in the present specification, the "polymer coating, when applied by methods in the art, tends to create bridges at small gaps or corners between stent struts. Also, in the conventional methods, wherein a coating process

takes place after a shaping process, it is almost impossible to selectively coat the stent. For example, it is impossible to coat one side of a stent without coating the other side or to apply different coatings to the outside and inside of a stent.” Present specification, page 1, line 32, to page 2, line 1. In contrast, “medical devices having multiple coating layers and a complicated geometry pattern can also be easily manufactured by the method of the present invention without flaws such as polymer-bridges at gaps or corners.” Specification, page 9, lines 21-23. Thus, the resultant medical device of Wang would not be the same as that presently claimed. Therefore, it is believed that claim 30 is patentable over Wang.

Accordingly, withdrawal of this rejection and allowance of claims 30-35 are respectfully requested.

II. CLAIM OBJECTION


The Examiner objected to the numbering of claims 35-66. As discussed above, the numbering of these claims has been corrected. Thus, withdrawal of this objection is respectfully requested.

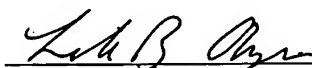
III. CONCLUSION

As the claim rejection and claim objection have been overcome, all pending claims are believed to be in condition for allowance. Should the Examiner not agree with Applicant’s position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the allowance of the application.

Respectfully submitted,

Date: May 12, 2006


Gidon D. Stern (Reg. No. 27,469)

By: 
Linda B. Azrin (Reg. No. 44,516)
JONES DAY
222 East 41st Street
New York, New York 10017
(212) 326-3939

Enclosures